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INTERNATIONAL BUSINESS MACHINES CORPORATION

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EXAMINER

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/730,227	Applicant(s) GOODMAN ET AL.	
	Examiner Dhairya A. Patel	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 29-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 29-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/9/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication filed on 3/9/2009.
2. This amendment has been considered and entered. Claims 1-10, 30-33 are subject to examination. Claims 11-29 are cancelled. Claims 34-52 are newly added claims.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 3/9/2009 was filed has been considered by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1,6,34,39,44,48 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,21,26 of

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copending Application No. 11/234,987 (hereinafter '987) in view of Leeds et al. U.S.

Patent Publication # 2002/0138588 (hereinafter Leeds) in further view of Appelman et

al. U.S. Patent # 6,539,421 (hereinafter Appelman)

As per claim 1 of the present application contains subject matter in '987 patent application of claim 1 that is similar as follows:

A method comprising the steps of: receiving at a second unidentified client, a first message to be published from a first client to subscribers including said first client, the first message related to a topic of interest, the first message being directed through a pub/sub service, the second client as being willing to receive message related to the topic of interest and being anonymous to the first client and said other subscribers of the pub/sub service and filtering the message received from the first client and passing message of specific interest to a second client and transmitting the second message by way of an instant message application from the second client to the first client; and said second client remaining anonymous to the first client.

'987 patent application does not teach in the event that the message passes said filtering at said second client, creating at the second client, a second message, comprising the first message and the first network address said first message in said second message providing context to said second and including further information pursuant to said specific interest in first message; retrieving additional information related to the second client; and presenting additional information at the first client.

Leeds teaches in the event that the message passes said filtering at said second client, creating at the second client, a second message, comprising the first message

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and the first network address said first message in said second message providing context to said second and including further information pursuant to said specific interest in first message (Paragraph 47-49).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in '987 patent application's teaching to come up with filtering messages at the client, and filtering passing messages of specific interest at the second client. The motivation for doing so would be so if the customer has a novel question related to a particular product, the customer service representative who is an expert in the particular product i.e. topic of interest can answer the question.

Leeds also does not teach retrieving additional information related to the second client; and presenting additional information at the first client. Appelman teaches retrieving additional information related to the second client (Fig. 9) (column 6 lines 1-7) (column 5 lines 46-65); and **NOTE:** The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client); presenting the second message and the additional information at the first client (Fig. 16-19) (column 9 lines 43-67) (Fig. 9), **NOTE:** The figures presenting the second message "Hi John" with online status field such as time stamp (additional information) at the client in (Fig. 16-19) "13:20:27 mroe 1934" at the client window. The figure teaches sending the message "mroe1934" but the first does not know if mroe1934 received the message.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in '987 patent application's teaching to come up with retrieving additional information related to the second client and presenting additional information. The motivation for doing so would be so the customer can find out the second client's expertise from the additional information, therefore the customer/first client can pose novel question related to the specific topic to the second client.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,10,31,33-37,43-46,52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson) in view of Leeds et al. U.S. Patent Publication # 2002/0138588 (hereinafter Leeds)

As per claim 1, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

-receiving at a second unidentified client, a first message to be published from a first client to subscribers including the first client, the first message related to a topic of

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interest (Fig. 3 element 134)(column 2 lines 1-6), the first client having a first network address (column 5 lines 32-42), the first message being directed through a pub/sub service, the second client being a subscriber to the service of the pub/sub service (column 9 lines 43-67)(Fig. 16-19) as being willing to receive messages related to the topic of interest (column 2 lines 20-30).

NOTE: The reference teaches second user receiving a first message from the first user, through the AIM service (pub/sub service) and receiving the message body and the address of the first client. The second client (i.e. mjohnson1934 and/or mroe1934) being subscriber to the AIM service (pub/sub service). The first message in this case is from ("PhillipsJC: Hey did you see the game last night") (Fig. 3 element 134). In column 2 lines 20-31, Appelman teaches indicate a willingness to answer question related to the topic of interest. Appelman shows that PhillipsJC's buddies are currently signed on thus available to receive instant messages (column 2 lines 20-31). The fact that other users/subscribers are signed on, it is obvious that they are available to receive message and therefore answer questions related to their interest.

-creating at the second client, a second message, the second message comprising the first message and the first network address (column 9 lines 43-67) (Fig. 16-19) said first message in said second message providing context to said second message (column 9 lines 43-67) (Fig. 16-19) and including an answer to the question contained in said message (Fig. 3 element 135) (column 2 lines 1-11);

NOTE: The reference teaches second user responding, and sending a second message "Hi John" comprising the first message which is "hello Mary" and the first

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address of "mroe1934" (first network address). The reference teaches first message (Fig. 15 element 604) in second message (Fig. 16 element 614) providing context "hello Mary" in the second message (Fig. 16 element 614). In Fig. 3 element 135 and column 2 lines 1-9, Appelman teaches creating at the second message including an answer to the question contained in said first message. In this case, Frsanfu responds to PhillipsJC question with a response "Unfortunately no, I had to take my dog to the Vet" which means the second message including an answer to the question ("PhillipsJC: Hey did you see the game last night").

-transmitting the second message by way of an instant message application from the second client to the first client (Fig. 16-19) (column 9 lines 30-66);

NOTE: The figures show that second message "Hi john" is sent by instant message application from the second client to the first client.

-retrieving additional information related to the second client (Fig. 9) (column 6 lines 1-7) (column 5 lines 46-65); and

NOTE: The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-presenting the second message and the additional information at the first client (Fig. 16-19) (column 9 lines 43-67) (Fig. 9),

NOTE: The figures presenting the second message "Hi John" with online status field such as time stamp (additional information) at the client in (Fig. 16-19) "13:20:27 mroe 1934" at the client window. The figure teaches sending the message "mroe1934" but the first does not know if mroe1934 received the message.

Appelman fails to teach second client being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers known only to said pub/sub service and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client and second message including an answer to the question contained in said first message.

Robertson also teaches first message including a question (i.e. I think the White Album is brilliant!") related to the topic of interest (i.e. newsgroup) (column 1 lines 49-57) the second client being a subscriber to the pub/sub service (column 2 lines 47-55) and being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers (i.e. user or authors) known only to said pub/sub service (i.e. forums) (column 2 lines 47-55) and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client (column 2 lines 61-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3). Robertson also teaches second client being a subscriber to the service of the pub/sub service as being willing to receive question related to the topic of interest (column 1 lines 49-67) and second message including an answer to the question contained in said first message (column 1 lines 49-57). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman's teaching to come up with having subscribers being anonymous' and second client remaining anonymous to the first client and other subscribers after said transmission of messages. The motivation for doing so

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would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed.

Appelman and Robertson are silent in teaching filtering at said second client the message received from said first client, said filter passing messages of specific interest to said client; in the event that the message passes said filtering at said second client,

Leeds teaches receiving at a second unidentified client, a first message to be published from a first client to subscribers including the first client, the first message related to a topic of interest (Paragraph 48,49), the first client having a first network address, the first message being directed through a pub/sub service, the second client being a subscriber to the service of the pub/sub service as being willing to receive messages related to the topic of interest (Paragraph 23349)

-filtering at said second client (i.e. customer service representative) the message received from said first client (i.e. customer), said filter passing messages of specific interest (i.e. question regarding particular product or pose question) to said client (Paragraph 49); in the event that the message passes said filtering at said second client, creating at the second client, a second message, comprising the first message and the first network address said first message in said second message providing context to said second and including further information pursuant to said specific interest in first message (Paragraph 47-49).

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in Appelman and Robertson's teaching to come up with filtering messages at the client, and filtering passing messages of specific interest at the second client. The motivation for doing so would be so if the customer has a novel question related to a particular product, the customer service representative who is an expert in the particular product i.e. topic of interest can answer the question.

As per claim 2, Appelman, Robertson and Leeds teaches the method according to claim 1, but Leeds further teaches the first message is received at the second client from the first client by way of pub/sub server (i.e. moderator who passes the questions to the customer service representative)(Paragraph 47-49)

As per claim 3, Appelman, Robertson and Leeds teaches the method according to claim 1, Leeds further teaches the first message is received at the second client from the first client to a channel of a publish/subscribe server (Paragraph 47-49)

Appelman and Leeds fails to teach subscribing being authenticated and authorized by said publish/subscribe server anonymous to other of said second or first clients. Robertson teaches subscribing being authorized and authenticated by the publish/subscribe channel anonymous to other of said second for first clients (column 2 lines 13-20, lines 45-67) (column 3 lines 1-13). It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman and Leeds's teaching to come up with subscribing being authenticated and authorized by server unknown to other first or second clients.

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The motivation for doing so would so that none of the unauthorized user can subscribe to the channel because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the channel will be prevented from responding or seeing to the help question.

As per claim 4, Appelman, Robertson, and Leeds teaches the method according to claim 1, but Appelman further teaches wherein the additional information comprises any one of a first user name, first user title, first user telephone number, first user job responsibility, first user secretary (Fig. 16)(column 25-42); and

NOTE: The reference teaches first user name which “John” or “mroe1934” (first user name).

As per claim 10, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

-creating at a first client (Fig. 15 element 600), a first message (Fig. 15 element “Hello Mary”) to be published related to a topic of interest (Fig. 3 element 134)(column 2 lines 1-6), the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title, a user telephone number, a user value, a user job responsibility or information about a user’s secretary (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches creating a message the first client a first message “Hello Mary”, the first message comprising the a user value (Fig. 15 element 634 “mroe1934”) or a time stamp at what time the message was sent.

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-transmitting the first message by way of an instant message application from the first client to a second client (column 9 lines 25-42) (Fig. 15-16) who has registered with the pub/sub service as a subscriber to messages related to said topic of interest, the second client being unaddressed by the first client (Fig. 14) (Fig. 15) (column 9 lines 18-29),

NOTE: The reference teaches transmitting the first message by instant message application from first client to the second client.

-retrieving at the second client, the additional information (Fig. 16) (column 25-42) and said message (Fig. 3 element 134); and

NOTE: The reference teaches at the second client (Fig. 16) receiving (Fig. 16 element "more1934" or "13:20:05" time stamp) (additional information) at the second client.

-presenting the first message and the additional information and said message (Fig. 3 element 134) at the second client (Fig. 16) (column 25-42) (column 2 lines 1-9);

NOTE: The figure 16 teaches presenting the first message "Hello Mary" and the additional information (13:20:05 or mroe1934), which is a time stamp and a user value.

-second message including an answer to the question including in said first message (Fig. 3 element 135) (column 2 lines 1-10).

Appelman fails to teach second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service; and transmitting a second message from the second client to the first client said

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second client remaining anonymous to the first client and other subscribers of said pub/sub service after said second message is transmitted to said first client.

Robertson teaches second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service; and transmitting a second message from the second client to the first client said second client remaining anonymous to the first client and other subscribers of said pub/sub service after said second message is transmitted to said first client (column 2 lines 45-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3) second message including an answer ("I agree with you!") to the question ("I think the white album is brilliant") including in said first message (column 1 lines 47-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman's teaching to come up with having second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service. The motivation for doing so would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed and also to send or propose a help question to people in the channel and having other people in the channel responds with the answer from the channel.

Appelman and Robertson are silent in teaching filtering as second client said received message for messages of specific interest to said second client; in the event that the message passes said filtering as being of specific interest to said second client.

Leeds teaches creating at a first client (i.e. customer), a first message to be published related to a topic of interest (i.e. particular forum i.e. "anniversary chat" or "adaptive forum for particular products")(Paragraph 49), the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title (i.e. customer), a user telephone number, a user value (i.e. moderator), a user job responsibility or information about a user's secretary (Paragraph 45,49)

-filtering as second client (i.e. customer service representative) said received message for messages of specific interest to said second client (i.e. novel question regarding particular product or pose novel questions) (Paragraph 49); in the event that the message passes said filtering as being of specific interest to said second client presenting the first message and the additional information and said message at the second client; and transmitting a second message from second client directly to the first client said second client remaining anonymous to the first client and other subscribers of said pub/sub service after said second message is transmitted to said first client, said second message including further information pursuant to said specific interest included in said first message (Paragraph 49,51)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in Appelman and Robertson's teaching to come up with filtering messages at the client, and filtering passing messages of specific interest at the second client. The motivation for doing so would be specific users receive only message to which they are interested in or have

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signed up to receive only particular interest message in which they can provide their expertise.

As per claim 31, Appelman, Robertson and Leeds teaches the method according to claim 4, but Appelman further teaches wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link (such as a URL). (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

As per claim 33, Appelman, Robertson and Leeds teaches the method according to claim 10, but Appelman further teaches wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link such as a URL, a telephone message or command information for actuating a mechanical a device. (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

As per claims 34-37 respectively, teaches same limitations as claims 1-4 respectively, therefore rejected under same basis.

As per claim 43,52 respectively, teaches same limitations as claim 10 respectively, therefore rejected under same basis.

As per claims 44-46 respectively, teaches same limitations as claims 1-2,4 respectively, therefore rejected under same basis.

Claims 6-9,39-42,48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Leeds et al. U.S. Patent Publication # 2002/0138588 (hereinafter Leeds) further in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson)

As per claim 6, Appelman teaches a method for identifying a message initiator in a system for instant message, the method comprising the steps of:

- obtaining at a first client, first user identifying information (column 5 lines 46-65) (column 6 lines 1-6) (Fig. 9); **NOTE:** The figure teaches obtaining at the first client, the buddy list and the information about the first user identifying information "mroe1934" and his online status field.

- incorporating the first user identifying information in a message to be published (Fig. 16-19) (column 9 lines 43-67) (Fig. 9) said message including a question related to the topic of interest (Fig. 3 element 134) (column 2 lines 1-6). **NOTE:** The figures presenting "mroe1934" and his online status field such as time stamp (first user identifying information) in the message at the first client in (Fig. 16-19) "13:20:05 mroe1934" to be published.

- transmitting the message; publishing the message to subscribers (column 9 lines 25-42) (Fig. 15-16)

Appelman fails to teach a pub/sub server, i.e. transmitting the message to a pub/sub server; publishing the message to subscribers of the pub/sub server said

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subscribers being anonymous to said first user and other subscribers and being authenticated and authorized by said pub/sub server; and providing the message comprising the first user information to a subscriber who remains anonymous to said first user and said anonymous subscribers being known only to pub/sub server; and said second user subscriber remaining anonymous to said first user and other subscribers after the second message is transmitted to said first user.

Leeds teaches a pub/sub server (Adaptive Forum/moderator or Cattalk Forum or anniversary chat)(Paragraph 47) transmitting the message to a pub/sub server (Paragraph 47, 49); publishing the message to subscribers (i.e. customer service representative) of the pub/sub server subscribing to messages related to said specific topic (i.e. related to the particular product) (Paragraph 49) said subscribers being anonymous to said first user (i.e. customer) and other subscribers (Paragraph 49)

Leeds also teaches filtering at each subscriber (i.e. customer service representative/moderator) said published message for filtering said messages for messages of specific interest (i.e. novel question regarding products and services (paragraph 49); providing the filtered message comprising the first user information and said message related to the topic of interest and filtered to be of specific interest to a second user subscriber who remains anonymous to said first user (Paragraph 47,49); transmitting a second message responsive to said published message and including further information pursuant to said specific interest (i.e. novel questions and providing responses) in said first message from a second user subscriber directly to the first user,

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and said second user subscriber remaining anonymous to said first user and other subscribers after the second message is transmitted to said first user (Paragraph 49)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in Appelman's teaching to come up with filtering messages at the client, and filtering passing messages of specific interest at the second client. The motivation for doing so would be specific users receive only message to which they are interested in or have signed up to receive only particular interest message in which they can provide their expertise

Appelman and Leeds fails to teach subscribers being authenticated and authorized by said pub/sub server.

Robertson subscribers being authenticated and authorized by said pub/sub server and subscribers being anonymous to said first user and other subscribers (column 2 lines 13-20, lines 45-67)(column 3 lines 1-13) said anonymous subscribers being only to pub/sub server (column 2 lines 47-55); and second user subscriber remaining anonymous to said first user and other subscribers after the second message is transmitted to said first user (column 2 lines 61-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3).

It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman and Leeds's teaching to come up with subscribing being authenticated and authorized by server unknown to other first or second clients and subscribers being anonymous to pub/sub server and second client remaining anonymous to the first client. The motivation for doing so would be so that none of the unauthorized user can subscribe to

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the channel because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the channel will be prevented from responding or seeing to the help question and the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed.

As per claim 7, Appelman, Leeds and Robertson teaches the method according to claim 6 but Appelman further teaches wherein the providing step comprises the further steps of: acquiring second user information based on the first user identifying information in the message (Fig. 9)(column 6 lines 1-7)(column 5 lines 46-65); and **NOTE:** The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-providing the second user information to the subscriber (Fig. 16-19) (column 9 lines 43-67) (Fig. 9).

As per claim 8, Appelman, Leeds and Robertson teaches the method according to claim 6 but Leeds further teaches wherein the obtaining step comprises the further step of: transforming user information from any one of instant message (Fig. 32), text, audio, video or voice into the digital message (Paragraph 34,49)

As per claim 9, Appelman, Leeds and Robertson teaches the method according to claim 6 but Appelman further teaches wherein the presenting step comprises the further step of: transforming the message to any one of instant message, text, audio or

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video (Fig. 16-19) **NOTE:** The reference teaches the transforming the message into instant message.

As per claims 39-42 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

As per claims 48-51 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

Claims 5,30,32,38,47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson) further in view of Leeds further in view of Kapil et al. U.S. Patent # 6,941,345 (hereinafter Kapil)

As per claim 5, Appelman, Robertson, Leeds teaches the method according to claim 1 but fails to teach wherein any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator. Kapil teaches any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator (Column 5 lines 52-64)(column 6 lines 12-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman, Robertson, Leeds's teaches to come up with having first message or second message translated into any one of telephone message, a video display an audio message. The motivation for doing so would have been so that if the user does not have access to a computer to receive

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the first message or second message, he/she can still receive by a telephone message or audio message.

As per claim 30, Appelman, Robertson and Leeds teaches the method according to claim 1, but Leeds teaches comprising the further steps of: associating the second client with a channel of a publish/subscribe server (i.e. "chat forum" or "cattalk forum" or "adaptive forum")(Paragraph 47,49); the first client sending the first message to the channel of the publish/subscribe server (Paragraph 47); and the publish/subscribe server publishing the first message to the determined plurality of subscribers (Paragraph 47-49).

Appelman, Robertson and Leeds are silent in teaching determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client.

Kapil teaches determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client (column 12 lines 33-51). Kapil also teaches associating the second client with a channel of a publish/subscribe server (column 12 lines 9-32); the first client sending the first message to the channel of the publish/subscribe server (column 4 lines 16-49); the publish/subscribe server publishing the first message to the determined plurality of subscribers (column 4 lines 16-49) (column 12 lines 9-51).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman, Robertson and Leeds's teaching to come up with determining network address of the plurality of

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subscribers associated w/ the channel. The motivation for doing so would have been so that first user can check through the service provider in the community (pub/sub server) that the plurality of users exists and send a message, and if the plurality of users can have a conversation with the first user.

Appelman, Leeds and Kapil fails to teach second client being authenticated and authorized by said publish/subscribe server. Robertson teaches second client being authorized and authenticated by the publish/subscribe channel (column 2 lines 13-20, lines 45-67) (column 3 lines 1-13). It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman, Leeds and Kapil's teaching to come up with second client being authenticated and authorized by server. The motivation for doing so would be so that none of the unauthorized user can subscribe to the forum because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the forum will be prevented from responding or seeing to the help question.

As per claim 32, Appelman, Robertson, Leeds teach the method according to claim 6, but Leeds further teaches wherein the transmitting step comprises the further steps of: the first client associating the first message to be transmitted with a channel of the pub/sub server (i.e. "chat forum" or "cattalk forum" or "adaptive forum")(Paragraph 47,49); the pub/sub server receiving the first message from the first client (paragraph 47); wherein the publishing step comprises the further step of publishing the first

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message to the plurality of subscribers associated with the channel of the pub/sub server (Paragraph 47-49)

Appelman, Robertson, Beaver are silent in teaching the pub/sub server determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client.

Kapil teaches pub/sub server determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client (column 12 lines 33-51)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman, Robertson and Leeds's teaching to come up with determining network address of the plurality of subscribers associated w/ the channel. The motivation for doing so would have been so that first user can check through the service provider in the community (pub/sub server) that the plurality of users exists and send a message, and if the plurality of users can have a conversation with the first user.

As per claim 38, 47, teaches same limitations as claim 5, therefore rejected under same basis.

Response to arguments

. Applicant's arguments filed 3/9/2009 have been fully considered but they are not persuasive.

As per remarks, applicant stated the following:

A). Applicant states Appelman or Robertson does not teach “second subscriber being a subscriber to the service of the pub/sub service as being willing to receive messages related to the topic of interest and being anonymous to the first client and other subscribers of the pub/sub service”.

As per remark A, Examiner respectfully disagrees with the applicant because in column 2 lines 47-67 and column 1 lines 49-57, Robertson teaches first message including a question (i.e. I think the White Album is brilliant!) related to the topic of interest (i.e. newsgroup) (column 1 lines 49-57) the second client being a subscriber to the pub/sub service (column 2 lines 47-55) and being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers (i.e. user or authors) known only to said pub/sub service (i.e. forums) (column 2 lines 47-55) and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client (column 2 lines 61-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3). Robertson also teaches second client being a subscriber to the service of the pub/sub service as being willing to receive question related to the topic of interest (column 1 lines 49-67) and second message including an answer to the question contained in said first message (column 1 lines 49-57).

In this case the topic of interest is newsgroup which has new topic for discussion which is published to the forum (i.e. pub/sub service) which has other subscriber which includes a second subscriber who is willing to answer the question related topic of interest. Therefore, It would have been obvious to one of ordinary skill in the art at the

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time of applicant's invention was made to implement Robertson's teaching in Appelman's teaching to come up with having subscribers being anonymous' and second client remaining anonymous to the first client and other subscribers after said transmission of messages. The motivation for doing so would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed.

Examiner would also like to point out that Leeds in Paragraph 47,49, teaches Leeds teaches receiving at a second unidentified client, a first message to be published from a first client to subscribers including the first client, the first message related to a topic of interest (Paragraph 48,49), the first client having a first network address, the first message being directed through a pub/sub service, the second client being a subscriber to the service of the pub/sub service as being willing to receive messages related to the topic of interest (Paragraph 23349)

-filtering at said second client (i.e. customer service representative) the message received from said first client (i.e. customer), said filter passing messages of specific interest (i.e. question regarding particular product or pose question) to said client (Paragraph 49); in the event that the message passes said filtering at said second client, creating at the second client, a second message, comprising the first message and the first network address said first message in said second message providing context to said second and including further information pursuant to said specific interest in first message (Paragraph 47-49).

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Leeds's teaching in Appelman and Robertson's teaching to come up with filtering messages at the client, and filtering passing messages of specific interest at the second client. The motivation for doing so would be so if the customer has a novel question related to a particular product, the customer service representative who is an expert in the particular product i.e. topic of interest can answer the question.

B). Applicant states the motivation to combine or suggestion must be from the references i.e. examiner must show teaching or suggestion in the prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed. Examiner would like to point out that this would generally available to one of ordinary skill in the art.

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Applicant's arguments with respect to claims 1-10,30-33 in particularly with Beavers reference have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Voice Instant messaging" by Wu et al. U.S. Patent Publication # 2002/0023131 A1.

B) "Video Messaging" by Enete et al. U.S. Patent Publication # 2003/0208543 A1.

A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A. Patel whose telephone number is 571-272-5809. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DAP

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451